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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,648	06/18/2001	Lisa R. Etzel	P04887US0	1835
22885	7590	10/14/2003	EXAMINER	
MCKEE, VOORHEES & SEASE, P.L.C. 801 GRAND AVENUE SUITE 3200 DES MOINES, IA 50309-2721			WINSTON, RANDALL O	
			ART UNIT	PAPER NUMBER
			1654	

DATE MAILED: 10/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/883,648	<b>Applicant(s)</b> ETZEL ET AL.	
	<b>Examiner</b> RANDALL WINSTON	<b>Art Unit</b> 1654	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) 1-43 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-14, drawn to a method for producing a whey protein isolate from a casein containing milk starting material containing obtaining de-creamed milk starting material, classified in class 424, subclass 535, for example.
  - II. Claims 15-22, drawn to a method for producing a whey protein isolate from whey starting material comprising removing lipids from said whey starting material, by the addition of a silicon dioxide etc., classified in class 424, subclass 535, for example.
  - III. Claims 23-36, drawn to a method for producing a clarified whey protein isolate from a milk starting material comprising introducing and effective amount of silica to said decaseinated starting material etc., classified in class 424, subclass 535, for example.
  - IV. Claim 37, drawn to a whey protein isolate product purified from milk starting material produced by the method of claim 1, classified in class 424, subclass 440, for example.

- V. Claim 38, drawn to a whey protein isolate prepared from milk starting material, said isolate produced by the method of claim 15, classified in class 424, subclass 440, for example.
- VI. Claim 39, drawn to a whey protein isolate prepared from milk starting material, said isolate produced by the method of claim 23, classified in class 424, subclass 441, for example.
- VII. Claim 40, drawn to a whey protein isolate produced from milk starting material, wherein said isolate comprises approximately 80% or greater and preferably 90% or greater protein content of said milk starting material, and wherein said protein isolate mimics the protein profile present in said starting material, classified in class 424, subclass 535, for example.
- VIII. Claim 41, drawn to a method for purifying a protein from casein containing milk, classified in class 530, subclass 344, for example.
- IX. Claims 42-43, drawn to a method for purifying a recombinant protein from casein containing milk, classified in class 530, subclass 344, for example.

2. The inventive groups above are directed to different inventions which are not connected in design, operation, and/or effect. These claimed methods such as Inventions

I, II, III, VIII, and IX methods are distinguishable, each from the other, because they are five unrelated methods. The five method's preamble and/or objectives are either a method for producing a whey protein isolate or a clarified whey protein isolate as demonstrated by Inventions I-III. (Invention I, e.g. the isolate is isolated from a casein containing milk starting material—Invention II, e.g. the isolate is isolated from whey starting material comprising an addition step of a silicon dioxide—Invention III, e.g. the clarified isolate is isolated from a milk starting material comprising by introducing and effective amount of silica) or a method for purifying a protein or purifying recombinant protein as demonstrated by Inventions VIII and IX (e.g. the essential steps of producing then purifying a protein is unrelated to the essential steps of producing then purifying a recombinant protein). Therefore, these five unrelated methods utilize different essential steps to achieve its preamble objective of producing and/or purifying.

Moreover, the claimed compositions such as Inventions IV-VII are distinguishable, each from the other, because they are four unrelated compositions. These four compositions are unrelated because these four compositions will contain different active ingredient and/or different active ingredients amounts because they are prepared by different methods.


Furthermore, the compositions and/or methods are not disclosed as capable of use together because they have different modes of operation, they have different functions, and/or they have different effects. One would not have to practice the various methods and/or use the various compositions at the same time to practice just one method alone and/or one composition alone.

3. The several inventions above are independent and distinct, each from the other. They have acquired a separate status in the art as separate subject for inventive effect and require independent searches (as indicated by the different classification). The search for each of the above inventions is not co-extensive particularly with regard to the literature search. Further, a reference which would anticipate the invention of one group would not necessarily anticipate or even make obvious another group. Finally the consideration for patentability is different in each case. Thus, it would be an undue burden to examine all the above inventions in one application.

Applicant is advised that the reply to this requirement to be completed must include an election of the invention to be examined even though the requirements be traversed (37 CFR 1.143).

An inquiry concerning this communication should be directed to Randall Winston at telephone number (703) 305-0404. The examiner can normally be reached during the hours of 08:30 to 17:00 Eastern.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to the receptionist whose telephone number is (703) 308-0196 or the Supervisory Patent Examiner, Brenda Brumback whose telephone number is (703) 306-3220.

  
**BRENDA BRUMBACK**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**